

**Paper P6 – Infringement and Validity of UK Patents**

<i>Element</i>	Syllabus
<i>Level</i>	JEB Advanced Paper
<i>Prerequisites</i>	Either P1 OR Trade Mark Foundation Paper T2 and Common Foundation Papers (OR be exempt from the Common Foundation Papers)
<i>Aim</i>	To test competencies expected of a patent attorney in advising on UK patent infringement and validity issues. Advice should be based on a knowledge of the legal framework and be appropriate to the facts provided and the client's needs.
<i>Competencies tested</i>	<p><b>Personal Effectiveness:</b></p> <ul style="list-style-type: none"> <li>• Sees the overall picture.</li> <li>• Is able to understand and interpret patents and other technical information.</li> <li>• Assimilates data and information provided to extract the issues.</li> <li>• Is able to reach an informed opinion on a finely balanced point.</li> <li>• Is able to use the information available to support the opinion reached.</li> <li>• Proposes actions solely on the basis of the information available in the question.</li> <li>• Identifies further information that may be required for a final opinion.</li> </ul> <p><b>Communicating and Influencing:</b></p> <ul style="list-style-type: none"> <li>• Identifies key issues and where appropriate the alternative scenario or interpretation.</li> <li>• Communication is clear, advisory, persuasive and informative.</li> </ul> <p><b>Delivering Results:</b></p> <ul style="list-style-type: none"> <li>• Advice reflects the client's needs and priorities.</li> <li>• Proposals are based on balanced analysis of information, risks and costs.</li> <li>• Proposals are practicable and achievable.</li> </ul> <p><b>Knowledge:</b></p> <ul style="list-style-type: none"> <li>• Has a thorough knowledge and understanding of the key aspects of law and practice relating to validity and infringement of UK patents.</li> <li>• Can exploit that knowledge in advising clients.</li> </ul>

<p><i>Knowledge required</i></p>	<ol style="list-style-type: none"> <li>1. Patentable inventions.</li> <li>2. Amendment of patents and patent applications.</li> <li>3. Infringement including consequences of partial validity, right to continue use, effect of publication, burden of proof.</li> <li>4. Revocation of Patents and putting validity in issue.</li> </ol> <p><b>The Annex sets out legislation underlying the above themes.</b></p>
<p><i>Assessment method and success criteria</i></p>	<p>Unseen examination lasting 4 hours.</p> <p>The examination paper will comprise a letter from a client or another document explaining the problem, a patent that is potentially infringed, and no more than four other documents that may be relevant to the infringement and/or validity of the patent being considered; documents may be relevant to more than one aspect of the problem.</p> <p>Candidates are expected to analyse and interpret the information and prepare a memorandum, setting out their opinion on one or more of the following (according the requirements of the situation):</p> <ol style="list-style-type: none"> <li>a. what is a tenable construction of the patent claims, supported by reasoning based on and referring to matter disclosed in the documentation where appropriate;</li> <li>b. whether the alleged infringement(s) do in fact infringe the patent concerned;</li> <li>c. the validity of the claims of the patent concerned in all relevant circumstances;</li> <li>d. the possibility of amending the patent concerned to improve the prospects of enforcement;</li> <li>e. "design around" possibilities to avoid the protection offered by a patent under consideration;</li> <li>f. options available to the client; and</li> <li>g. an indication of further information that might be needed; and an indication only of any other practice points that might be raised by the situation.</li> </ol> <p>Candidates gaining 50 percent or more of the marks available for the paper will be deemed to have passed the examination.</p>

<i>Reading list</i>	<ul style="list-style-type: none"> <li>• The CIPA Guide to the Patents Acts and supplements (pub. Thompson - Sweet and Maxwell) including the cases discussed in the commentary on those parts of the Patents Act set out in the Annex</li> <li>• Terrell on the Law of Patents (Sweet and Maxwell)</li> </ul>
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**ANNEX - SCOPE OF THEMES**

THEME	Legislative Background
1. Patentable Inventions	PA 1 - Patentable Inventions PA 2 - Novelty PA 3 - Inventive Step PA 4 - Industrial Application
2. Amendment of patents and patent applications	PA 19 and 27 - General powers to amend PA 75 - Amendment of patent in infringement or revocation proceedings PA 76 - Amendments of applications and patents not to include added matter PA 117 - Correction of errors in patents and applications
3. Infringement	PA 60 - Meaning of Infringement PA 61 - Proceedings for Infringement of patent PA 125 - Extent of invention

PA = Patents Acts 1977 to 2004 (as in force at 1 June 2010)